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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.    | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------|------------------|
| 10/822,278  | 04/12/2004  | Brain C. Carruth     | AUT.P0022              | 2168             |
| 7590 03/15/2006   |             |                      | EXAMINER               |                  |
| Edward G. Greive<br>Renner, Kenner, Greive, Bobak, Taylor & Weber<br>Fourth Floor<br>First National Tower<br>Akron, OH 44308-1456 |             |                      | KOEHLER, CHRISTOPHER M |                  |
|   |             |                      | ART UNIT               | PAPER NUMBER     |
|   |             |                      | 3726                   |                  |
| DATE MAILED: 03/15/2006   |             |                      |                        |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

|                              |   |  |  |
|------------------------------|---|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/822,278      | <b>Applicant(s)</b><br>CARRUTH, BRAIN C. |  |
|                              | <b>Examiner</b><br>Christopher M. Koehler | <b>Art Unit</b><br>3726                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 2,3,6 and 7 is/are allowed.
- 6) ☐ Claim(s) 1,4,5 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-7, in the reply filed on January 30, 2006 is acknowledged. The traversal is on the ground(s) that the method and apparatus are not distinct. This is not found persuasive because the Group I does not require the step of establishing or measuring the gap of the piston ring (claim 8, line 1), or inserting the piston ring into the cylinder as in Group II. Group I requires that the piston ring is inside the bore but gives no instruction as to how it arrives there and there is no mention of measuring the gap of the piston ring.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: Piston Ring Sizing Device.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 4, 5 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsumiya et al (US Patent No. 6,594,915).

5. Regarding claim 1, Matsumiya teaches a device inherently capable of being adapted to position a ring in a cylinder so that the ring is perpendicular to the axis of the bore comprising, a first segment (1, figure 1) having a tongue, a second segment (11) having a groove adapted to receive the tongue, the tongue being held in the groove at a predetermined position dependent on the diameter of the bore, the first and second segments each having a surface adapted to be received in the bore (2 and 12 respectively), the surfaces being of the same height so that when positioned in the bore the bottom of the surfaces engage the ring to position the ring perpendicular to the axis of the bore, wherein the first and second segments each include a lip above the surfaces, the lip extending radially outward of the surfaces at a right angle to said surfaces.

6. Regarding claim 4, Matsumiya teaches a means to attach said first segment to said second segment (14).

7. Regarding claim 5, Matsumiya teaches that the means include a hand screw having a threaded shaft.

8. Regarding claim 14, Matsumiya teaches a device inherently capable of being adapted to position a ring in a cylinder so that the ring is perpendicular to the axis of the bore comprising, a first segment (1, figure 1) having a tongue, a second segment (11) having a groove adapted to receive the tongue, the tongue being held in the groove at a predetermined position dependent on the diameter of the bore, the first and second segments each having a surface adapted to be received in the bore (2 and 12 respectively), the surfaces being of the same height so that when positioned in the bore the bottom of the surfaces engage the

ring to position the ring perpendicular to the axis of the bore, wherein the surfaces extend laterally outward of the tongue and are adapted to contact the ring outward of the tongue.

***Allowable Subject Matter***

9. Claims 2, 3, 6 and 7 are allowed.

10. The examiner's statement of reasons for allowance of claim 6 and its dependent claims can be found in the previous office action.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

11. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory

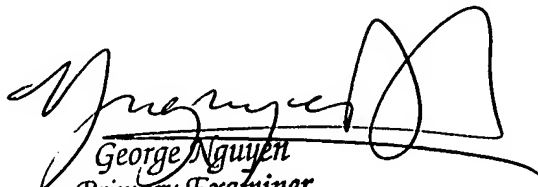
period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571) 272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Nguyen can be reached on (571) 272-4491. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CMK



George Nguyen  
Primary Examiner